

60,137-577; 275-3119-U

**REMARKS**

Claims 1-6, 8, 10, 12-15, and 45-53 remain pending in the application including independent claims 1, 8, 12, 45, and 50. Claims 7, 9, 11, and 16-44 have been cancelled. New claims 54-66 have been added including independent claim 60.

Claims 8, 10, and 45-53 have been allowed. Claims 5 and 15 are indicated as allowable.

Claim 8 has been amended in response to the claim objections identified at Section 2 of the present office action.

Claims 1-4, 6, and 12-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Spangler (US 627012) in view of Wright et al. (US Pub. 2004/0046802), Lodwick (US 2203167) and Simonis (US Pub. 2004/0004639).

The examiner admits that Spangler does not disclose arranging colors in a display so that they are varying in hue in one direction and chroma in a second direction. The examiner relies on Wright to teach this feature, and argues that it would be obvious to modify Spangler to provide a more intuitive and easier way to select colors by organizing colors in such a way so that they are harmonious to one another. Applicant respectfully disagrees and asserts that there is no motivation or suggestion to modify Spangler in the manner proposed by the examiner. Further, even if motivation could be found, the modification proposed by the examiner would not result in the method as defined in claim 1.

When it is necessary to select elements from different references in order to form the claimed invention, there must be some suggestion or motivation to make the selection. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. The extent to which such suggestion must be explicit in, or referred from, the references, is decided on the facts of each application in light of the prior art and its relationship to the claimed invention. It is impermissible to engage in a hindsight reconstruction of the claimed invention, using applicant's structure as a template and selecting elements from the references to fill the gaps. The references themselves must provide some teaching whereby applicant's combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

60,137-577; 275-3119-U

By combining the above-mentioned four references the examiner is clearly engaging in a hindsight reconstruction of the claimed invention using applicant's structure as a template and selecting individual features from each of the references in an attempt to arrive at the claimed invention. The examiner has not provided sufficient motivation or suggestion to support these proposed modifications. This will be specifically addressed below with regard to each of the modifying references.

One of the primary objectives of Spangler was to provide an improved color display based on lightness values, with the focus being to emphasize lighter pastel colors. See col. 2, lines 12-49. Spangler accomplishes this objective by providing a display unit where elongated strips are laid out side-by-side in a plurality of horizontal rows where the adjacent color stripes in a given row are closely related in color. One of the advantages of this arrangement is to reduce the number of cards to be selected by a customer to take home. See col. 4, lines 29-41.

The examiner seeks to modify Spangler to incorporate the teachings of Wright to result in a rearrangement of the colors displayed in the Spangler system. Such a modification would clearly defeat the beneficial arrangement that is already provided by Spangler. As set forth at MPEP 2143, to establish a *prima facie* case of obviousness there must be some suggestion or motivation to modify the reference, there must be a reasonable expectation of success, and the reference must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed modification and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully asserts that there is no motivation or suggestion to modify Spangler in the manner proposed by the examiner because the proposed modification would render the prior art unsatisfactory for its intended purpose (see MPEP 2143.01 (V)) and would change the principle of operation of the reference (see MPEP 2143.01 (VI)). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 7233 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As discussed above, Spangler discloses a specific arrangement of color cards to make selection easier for customers. The

60,137-577; 275-3119-U

examiner argues that it would be obvious to modify this beneficial arrangement of Spangler to arrange the colors in a different configuration. This would clearly render Spangler unsatisfactory for its intended purposes, especially as entire invention of Spangler is directed to the specifically disclosed color arrangement.

Additionally, the examiner's proposed modification would change the principle of operation of the prior art invention. Modifying Spangler to change the arrangement of colors would result in customers having to modify their color selection process. Spangler specifically teaches that in order to accomplish the goal of the invention, colors must be arranged as disclosed.

Further, the examiner has pointed to no teaching in Wright of any particular benefit to using the Wright color arrangement in lieu of that already taught by Spangler. The examiner has only set forth a general assertion that it would be more harmonious and easier for selection purposes without providing any evidence to support this assertion. In addition, there is nothing in Spangler that would have led one of ordinary skill in the art to believe that Spangler's arrangement was in any way deficient for Spangler's purposes or was in need of modification, especially as the Spangler arrangement was specifically designed to achieve an easier selection process for customers. One of ordinary skill in the art would have found no reason, suggestion, or incentive for attempting to combine these references so as to arrive at the claimed subject matter of claim other than through the luxury of hindsight accorded one who first viewed applicant's disclosure.

Also, even if motivation could be found to modify Spangler with the teachings of Wright, the result would not be the invention as defined in the claims. Wright is directed to a computerized color selection system and makes no reference to paint sample cards. Wright teaches using a screen selection process that displays a dominant pallet, a supporting pallet, and a large 20 x 9 column/row configuration with a plurality of different colors. Contrary to the examiner's assertions there is no teaching or suggestion found in Wright that would indicate that colors should be arranged as defined in claim 1.

Thus, for these reasons alone, claim 1 is allowable over the recited combination of references. For similar reasons claims 2-4, 6, and 12-14 are also allowable.

60,137-577; 275-3119-U

The examiner has also admitted that Spangler and Wright do not disclose arranging color combination paint sample cards adjacent to each group of different hue and chroma paint sample cards. The examiner relies on Lodwick for this feature and argues that it would be obvious to modify Spangler to create a system that displays colors, accurately names the colors, gives mixing formulas, and further related complementary colors to a particular selected color. Applicant respectfully disagrees.

Spangler teaches a display system where each display card only includes closely related colors of a similar hue. See col. 4, lines 6-15. The purpose of this is to reduce the number of cards that have to be taken home by a customer. Lodwick discloses a system where a first book of color sheets includes base colors and a second book of color sheets includes complementary colors. The books are separate from each other, and none of the sample sheets includes a base color that is tied to a complementary color on a single sample sheet. The user must flip between the books to find the complementary colors.

The examiner argues that it is obvious to modify Spangler to include a color combination paint sample card as claimed, but none of the references teach the use of a color combination card in a display system. Claim 1 recites that the color combination card includes a base hue that is the same hue as the hue that the card is adjacent to. The examiner has admitted that Spangler and Wright do not disclose this feature. Lodwick also does not disclose this feature. There is no disclosure in Lodwick of a single color combination card that includes a paint sample with a base hue that is the same as the hue that the card is adjacent to. Instead, Lodwick discloses a separate book of complementary colors that can be associated by a user to another book of base colors.

There is absolutely no disclosure in any of the references that would indicate that complementary color samples should be included on a color combination paint sample card along with a base hue sample as claimed. This is only found in applicant's disclosure. Thus, for these additional reasons claims 1-4, 6, and 12-14 are also allowable over the recited combination.

The examiner has also admitted that Spangler, Wright, and Lodwick do not disclose displaying a picture of a building or room on the color combination paint sample card. The examiner relies on Simonis for this feature and argues that it would be obvious to modify Spangler with the teachings of Simonis to provide a visual preview of what the colors would

60,137-577; 275-3119-U

look like. Applicant respectfully disagrees and asserts that there is no motivation or suggestion to modify Spangler in the manner proposed by the examiner.

Simonis actually teaches away from the use of paint sample cards arguing that colors on paint sample cards can look good together when laid side-by-side, but when these samples are actually painted on a large structure the color combinations do not have the desired effect. See abstract. Thus, Simonis does not suggest or hint at modifying a paint sample card to include a picture of a building or room as defined in the claims. This is a clear case of hindsight reconstruction where the examiner has hand picked different elements from various references and combined the elements together without providing sufficient motivation or suggestion as to why one of ordinary skill in the art would be desirous of doing so.

Further, Simonis is directed to providing a user selected color combination that is entered into a program that then takes the colors and applies them to the selected structure. There is absolutely no disclosure in Simonis of pre-selected configurations using a building or room that would be displayed on a single color combination paint sample card as claimed. Thus, for the many reasons set forth above, claims 1-4, 6, and 12-14 are allowable over the recited references.

Also, the examiner has taken Office Notice within the Simonis rejection to argue that it would be obvious to physically print out the display of Simonis and relies on this to modify Spangler to include this picture displayed on color combination paint sample card as claimed. Applicant respectfully traverses this Office Notice, especially in light of the teachings of Simonis which indicate that paint sample cards are disfavored. Applicant respectfully requests that the examiner provide a reference that discloses a color combination paint sample card with a picture as defined in the claims.

Finally, new claims 54-66 have been added. These claims are also allowable over the recited references for the many reasons set forth above.

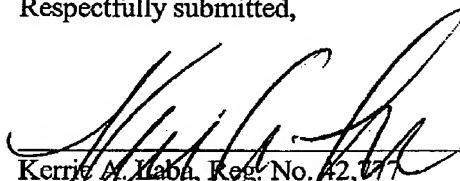
RECEIVED  
CENTRAL FAX CENTER

JUL 10 2008

60,137-577; 275-3119-U

Applicant respectfully asserts that all claims are now in condition for allowance and requests an indication of such. Fees in the amount of \$860.00 for six additional claims over twenty, plus one additional independent claim, may be charged to Deposit Account no: 50-1482 in the name of Carlson, Gaskey & Olds. Applicant believes that no additional fees are necessary; however, the Commissioner is authorized to charge the same Deposit Account for any additional fees or credit the account for any overpayment.

Respectfully submitted,

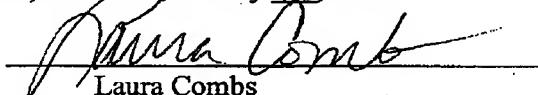


Kerris A. Kaba, Reg. No. 42,711  
Carlson, Gaskey & Olds  
400 W. Maple Road, Ste. 350  
Birmingham, MI 48009  
(248) 988-8360

Dated: July 10, 2008

## CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, fax number (571) 273-8300, on July 10, 2008.



Laura Combs